

Serial No.: 10/036,746

Docket No.: KCC-15,796

REMARKS

Applicants respectfully request reconsideration of this Patent Application, particularly in view of the above Amendment and the following remarks. No additional fee is required for this Amendment as the number of independent claims has not changed, and the total number of claims has been reduced.

Amendment to the Claims

Applicants amended independent Claim 1 to include limitations of dependent Claim 42, which the Office Action indicates contains allowable subject matter. Claim 42 has been canceled. Claims 88-96 have been canceled, without prejudice, according to the requirement in the Office Action. No new matter has been added to the claims by this Amendment. This Amendment should be entered as it places Claim 1 in condition for allowance.

Election/Restriction

The Office Action appears require cancellation of nonelected Claims 4, 5, 7, 12, 15, 16, 23, 24, 31, 35-40, 61, 62, 64, 66, 72-74, 81-86, and 88-116. Applicants' disagree with this requirement in part. Claims 88-96 have been canceled.

Claims 4, 5, 7, 12, 15, 16, 23, 24, 31, 35-40, 61, 62, 64, 66, 72-74, and 81-86 depend from generic base Claims 1 and 57, respectively, and are to be rejoined upon the allowance of the base claims. Claim 1 has been amended to include limitations of Claim 42, indicated as allowable in the Office Action. Claim 57 is allowable for the reasons detailed below.

Claims 97-116 are directed to a process of making the product of Claim 1. Claims 97-116 depend from Claim 1, and thus contain all limitations of

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Claim 1, which is now in condition for allowance. Claims 97-116 are to be rejoined pursuant to MPEP 821.04, which states:

Furthermore, where restriction was required between a product and a process of making and/or using the product, and the product invention was elected and subsequently found allowable, all claims to a nonelected process invention must depend from or otherwise require all the limitations of an allowable claim for the claims directed to that process invention to be eligible for rejoinder. (emphasis in original)

Claim Rejections - 35 U.S.C. §102

The rejection of Claims 1-3, 6, 8-11, 13, 14, 17-22, 25-30, 32-34, 41, 45-60, 63, 65, 67, 68, 70, 71, 75, 76, 78-80, and 87 under 35 U.S.C. §102(e) as anticipated by Tanzer et al., U.S. Patent 6,429,350, is respectfully traversed. Claim 1 has been amended to include limitations of Claim 42, indicated as allowable in the Office Action.

Independent Claim 57 recites the superabsorbent material is fused onto the surge material. The superabsorbent material is fused onto the surge material because, as disclosed in the Specification, Applicants' claimed invention is desirably formed using a superabsorbent precursor that is applied, such as by printing, to the surge material. The precursor is then, for example, dried and crosslinked to fuse onto, the surge material, resulting in a novel and beneficial superabsorbent/surge material structure, as shown in the figures.

The Tanzer et al. Patent discloses forming a plurality of pockets within a surge material and filling the pockets with particulate superabsorbent material (Abstract; Col. 4, lines 4-21; Col. 5, lines 13-16). The superabsorbent particles deposited in the pockets are not fused onto the surge material.

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The Tanzer et al. Patent does not disclose or suggest a superabsorbent material fused onto the surge material, as in Applicants' claimed invention. However, the Office Action states that the term "fused" is considered a product-by-process limitation¹. Applicants' respectfully disagree. The final structure of the surge composite includes a superabsorbent material fused onto the surge material. The process by which the fused superabsorbent material is formed includes, for example, applying a precursor solution to the surge material and ultimately crosslinking the precursor.

The limitation "a superabsorbent material fused onto the surge material" is a structural or product limitation in that it defines a physical characteristic of the superabsorbent material in the discrete regions of the final product. This limitation describes an observable structural characteristic of the connection between the superabsorbent material and the fibers of the surge material. *See In re Garnero*, 162 USPQ 221, 223 (Fed. Cir. 1969) (recitation of "interbonded one to another by interfusion" construed as a structural limitation, noting "intermixed," "ground in place," "press fitted," "etched," and "welded" have all been so construed); *See also 3M Innovative Properties Co. v. Avery Dennison Corp.*, 69 USPQ2d 1050 (Fed. Cir. 2003), *cert denied*, 124 S. Ct. 2877 (2004) ("superimposed" and "embossed" are structural limitations, not product-by-process limitations). The Office Action is incorrectly designating the limitation "fused" as a process limitation, and this product limitation is to be considered for patentability.

¹ The term "fused" previously replaced "bonded," which was not considered a product-by-process limitation.

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Furthermore, even assuming the term "fused" is a product-by-process limitation, the Examiner is incorrect in not giving the term patentable weight. As provided in MPEP §2113:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where *the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.* (emphasis added)

The resulting structure of Applicants' invention differs markedly from the Tanzer et al. material *because* of the fused superabsorbent material (and the process of crosslinking a superabsorbent precursor applied to the surge material). The fused superabsorbent material imparts a distinctive structural characteristic to Applicants' final product, as shown in, for example, FIGS. 3B and 5, and the term "fused" should be considered for patentability of Claim 57.

The Tanzer et al. Patent discloses forming a plurality of pockets within a surge material and filling the pockets with particulate superabsorbent material. The Tanzer et al. Patent does not disclose a superabsorbent material fused onto fibers of a surge material in a discrete region, as in Applicants' claimed invention. The Tanzer et al. Patent does not anticipate Claim 57, or claims depending therefrom.

Favorable reconsideration and withdrawal of this rejection are respectfully requested.

Allowable Subject Matter

Applicants thank the Examiner for her efforts in indicating Claims 42-44 contain allowable subject matter. Claim 1 has been amended to include limitations of Claim 42, thereby placing Claim 1, and all claims depending therefrom in condition

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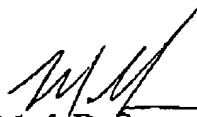
for allowance. Applicants respectfully assert all claims are now in condition for allowance.

Conclusion

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not resolved in this response, Applicants' undersigned attorney requests a telephone interview with the Examiner.

Applicants sincerely believe that this Patent Application is now in condition for allowance and, thus, respectfully request early allowance.

Respectfully submitted,


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